

REMARKS

Prior to entry of this Amendment:

- Claims **75-108** were pending in the present application
- Claims **75-108** stand rejected
- Claims **107 and 108** are objected to

Upon entry of this Amendment, which is respectfully requested for the reasons set forth below:

- Claims **75-108** will be pending
- Claims **78, 99-101, 107, and 108** will be amended
- Claims **75, 107, and 108** will be the only independent claims

A. Telephone Interview

We would like to thank the Examiner for the helpful telephone conversation held on January 11, 2005, with our representative.

The Examiner and our representative discussed the present application in light of Raven and Plainfield references.

Our representative suggested that all of the pending claims provide for a useful, concrete, and tangible result. With respect to Claim **75**, our representative noted that at least each one of the following steps produces a useful result: (i) transmitting the survey question to the player via a slot machine; (ii) receiving a response of the player to the survey question; (iii) determining compensation for the response; and (iv) transmitting a signal to the slot machine to provide the determined compensation to the player.

Our representative also noted that some of the Examiner's Section 103(a) rejections (*e.g.*, for Claims **80 and 82-97**) rely on unsupported Official Notice. The Examiner agreed to provide references supporting the asserted subject matter.

While no formal agreement was reached, we are grateful for the opportunity to discuss the present application with the Examiner.

B. Claim Amendments

B.1. Claim 78 has been amended

Although we do not believe that it is necessary for patentability, Claim **78** has been amended to recite that the predetermined amount is greater than zero. No new matter has been added.

B.2. Claims 107 and 108 have been amended

Although we do not believe such an amendment is necessary, Claims **107** and **108** have been amended in order to overcome the Examiner's objection. No new matter has been added and the amendments have not narrowed the scope of the claims. Independent Claims **107 and 108** have been rewritten to literally recite features previously claimed by reference. Specifically, independent Claim **107** now explicitly recites a computer readable medium storing instructions configured to direct the processor to perform the same method that is recited in Claim **75**. Independent Claim **108** now explicitly recites an apparatus comprising a computer readable medium storing instructions configured to direct the processor to perform the same method recited in Claim **75**. As the amendments to Claims **107 and 108** literally recite subject matter that was already claimed by reference, the amendments cannot be narrowing in scope.

We respectfully request that the Examiner withdraw the objection to Claims **107 and 108**.

B.3. Claims 99-101 have been amended

Although we do not believe such an amendment is necessary, each of Claims **99-101** is now amended to recite determining a particular condition, and transmitting a survey question in response to determining that respective condition. No new matter has been added.

C. Section 101 Rejection

Claims **75-108** are rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter "because they do not provide a useful, concrete and tangible result." [Office Action, page 2].

We traverse the Examiner's Section 101 rejection. For the reasons stated herein, we respectfully request that the Examiner withdraw the Section 101 rejection of Claims **75-108**.

C.1. The Basis for Rejection

As best as we understand the rejection of the claims for being directed to non-statutory subject matter, the basis for that rejection is: “The claims determine a compensation and merely *request* that the slot machine provide the compensation. Without the slot machine actually providing the compensation, no useful, concrete and tangible result is set forth.” [Office Action, page 2 (emphasis in original)].

As the rejection under Section 101 applies a standard that departs from the requisite legal analysis, the rejection is flawed.

C.2. The Claims Meet the Standard for Statutory Subject Matter

All pending claims produce a useful, concrete and tangible result.

Independent Claims **75, 107 and 108**, for example, produces a useful, concrete, and tangible result at least by any one or more of: (i) selecting a player to receive a survey question based on gambling history; (ii) transmitting a survey question to a player via a slot machine; (iii) receiving a response of a player to a survey question; (iv) determining compensation for a response; or (v) transmitting a signal instructing a slot machine to provide compensation to a player.

In State St. Bank, the Federal Circuit found a useful, concrete, and tangible result in the mere determining of “a final share price momentarily fixed for recording and reporting purposes and even accepted and relied upon by regulatory authorities and in subsequent trades,” even though Claim 1 at issue, for example, did not recite any of those potential uses of any “final share price.” 149 F.3d at 1373 (Fed. Cir. 1998). In other words, under the proper standard for statutory subject matter under § 101, contrary to the Examiner’s assertion, no “actual” use of a useful, concrete, and tangible result must be “set forth” for the claim to be statutory.

With respect to the independent claims, a response to a survey question, for example, may be relied upon by interested entities (e.g., marketers), much like “regulatory authorities” could accept and rely upon the determined “final share price” at issue in State St. Bank. Also, the determining of a player to whom to transmit a survey question may be relied upon by an entity transmitting survey questions (the independent claims expressly recite functionality for transmitting).

It is also worth noting that the requirement for a “useful invention” is to be evaluated for the invention, and is not dependent on the breadth of the claims. Thus, if one species of an invention claimed as a genus is found to be “useful”, utility for the genus is established. Raytheon Co. v. Roper Corp., 724 F.2d 951,

958, 220 USPQ 592, 598 (Fed. Cir. 1983), cert. denied, 469 U.S. 835 (1984) (“When a properly claimed invention meets at least one stated objective, utility under § 101 is clearly shown.”). Utility is to be evaluated in a simple “yes” or “no” fashion (i.e., does the invention as claimed possess or not possess utility). There is no subjective test for “utility” that must be deemed to be commensurate with the breadth of the claims being sought to be patented.

In contrast to the proper analysis under Section 101, the Examiner simply asserts, without any supporting legal authority, that any compensation determined in any claim must “actually” be provided for the claim to be statutory subject matter. Accordingly, the Examiner’s standard and analysis for whether a claim produces a useful, concrete, and tangible result is improper.

C.3. No *prima facie* Case That Any Claim Fails to Produce a Useful, Concrete, and Tangible Result

The Examiner’s requirement that any determined compensation must actually be provided is improper and legally baseless, as discussed above.

Without any explanation, the Examiner has focused his analysis on the determined compensation. The Examiner does not even mention any other features of any claims, and it is not clear whether the Examiner even considered other claimed features. For example, the Examiner does not provide any explanation as to why selecting to whom to provide a survey question, providing a survey question, or receiving a response to a survey question, are not useful, concrete, and tangible results of the claimed subject matter. We submit that any of such claimed functionality, generally recited in the independent claims, produces useful, concrete, and tangible results.

Further, the Examiner does not provide any explanation of why merely signaling or “requesting” a slot machine to provide determined compensation (as generally recited in the independent claims) is not a useful, concrete, and tangible result. We submit that transmitting a signal to a device (*e.g.*, a slot machine) for that device to provide a particular function (*e.g.*, provide compensation to a player) clearly produces a useful, concrete, and tangible result.

C.4. Request for Clarification

If this rejection is maintained, we respectfully request an appropriate and explicit basis for the test used in rejecting the claims (i.e., a useful result is only one that is “actually” used). Specifically, we respectfully request clarification as to

which of the following is the basis for the Examiner's test for a useful, concrete, and tangible result:

- a) this test is believed to be in accordance with some section of the MPEP, or instead
- b) this test is a formal policy of the U.S. Patent and Trademark Office.

If the basis is (a), the rejection should be withdrawn because no section of the MPEP sets forth such a test for statutory subject matter. Further, we are unaware of any statute or court decision supporting this test.

If the basis is (b), please clarify whether this test relies on a new statutory interpretation of 35 U.S.C. § 101 that has been adopted by the U.S. Patent and Trademark Office.

Also, we respectfully request that the Examiner (i) explain how the Examiner is interpreting “useful” (e.g., what is the minimal threshold for usefulness) and (ii) explain how none of the claimed subject matter satisfies the Examiner’s threshold for usefulness.

Also, we respectfully request that the Examiner clarify if any claim is being rejected under Section 101 for an alleged lack of utility and, if so, the basis for such a rejection.

D. Section 103(a) Rejection

Claims **75, 81, and 106-108** stand rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,429,361 issued to Raven et al. (“Raven”) in view of U.S. Patent No. 5,893,075 issued to Plainfield et al. (“Plainfield”).

Claims **79-80, 82, 83, 85-97, 99-101 and 105** stand rejected under 35 U.S.C. 103(a) as being unpatentable over Raven in view of Plainfield and, as we best understand the rejection, further in view of “Official Notice” or other asserted subject matter not supported by any evidence of record.

Claims **77 and 78** stand rejected under 35 U.S.C. 103(a) as being unpatentable over Raven in view of Plainfield and U.S. Patent No. 5,971,850 issued to Liverance (“Liverance”).

As we understand the rejection, Claims **76, 84, 102 and 103** stand rejected under 35 U.S.C. 103(a) as being unpatentable over Raven in view of Plainfield and the unsupported subject matter or, alternatively, over Raven, Plainfield, and Liverance.

Claim **98** is rejected under 35 U.S.C. 103(a) as being unpatentable over Raven in view of Plainfield and U.S. Patent No. 5,941,772 issued to Paige (“Paige”).

Claim **104** is rejected under 35 U.S.C. 103(a) as being unpatentable over Raven in view of Plainfield and U.S. Patent No. 5,090,734 issued to Dyer (“Dyer”).

Thus, every rejection relies on a combination of Raven and Plainfield.

We respectfully traverse the Examiner’s Section 103(a) rejections.

D.1. Factual Inquiries Required by *Graham* for Determination of Obviousness Under 35 U.S.C. § 103

In Graham v. John Deere Co., 383 U.S. 1, 148 U.S.P.Q. 459 (1966), the Supreme Court established the test for consideration and determination of obviousness under 35 U.S.C. § 103.

In Iron Grip Barbell Co. v. USA Sports Inc., the Federal Circuit explained how obviousness must be determined using the four-part Graham test:

we employ the four-part test set forth in Graham v. John Deere Co., 383 U.S. 1 (1966). **This test requires us to examine**

(1) the scope and content of the prior art;

(2) the level of ordinary skill in the art;

(3) the differences between the claimed invention and the prior art; and

(4) the objective evidence of nonobviousness. *Id.* at 17-18; see also 35 U.S.C. § 103 (2000).

392 F.3d 1317, 2004 U.S. App. LEXIS 25769, 5 (Fed. Cir. 2004) (emphasis added).

U.S. Patent and Trademark Office policy is also to follow Graham. Accordingly, examiners should apply the test for patentability under 35 U.S.C. § 103 as set forth in Graham. M.P.E.P. § 2141 “35 U.S.C. 103; the Graham Factual Inquiries”, p. 2100-120, 8th ed., Rev. 2 (May 2004).

Accordingly, the Examiner must conduct the four factual inquiries enunciated in Graham in determining obviousness of any claim.

D.1.1. Level of Ordinary Skill in the Art

Without a factual determination of the level of ordinary skill in the art, obviousness cannot be assessed properly. The critical question is whether a claimed invention would have been obvious at the time it was made to one with ordinary skill in the art. Custom Accessories, Inc. v. Jeffrey-Allan Indus., Inc., 807 F.2d 955, 962 (Fed. Cir. 1986). Thus, a determination of the level of ordinary skill in the art is an integral part of the Graham analysis. Ruiz v. A.B. Chance Co., 234 F.3d 654, 666 (Fed. Cir. 2000) (citing Custom Accessories, 807 F.2d at 962).

Ascertaining a level of ordinary skill in the art is thus necessary. M.P.E.P. § 2141.03. See Ryko Mfg. Co. v. Nu-Star, Inc., 950 F.2d 714, 718 (Fed. Cir. 1991) (“Hence, the level of ordinary skill in the art is a factual question that **must** be resolved and considered.”) (emphasis added). Some factors that may be considered are outlined at M.P.E.P. § 2141.03.

D.2. Prima Facie Case of Obviousness

In view of all factual information (discussed above), the Examiner must then make a determination whether the claimed invention “as a whole” would have been obvious to the hypothetical “person of ordinary skill in the art” when the invention was unknown and just before it was made. M.P.E.P. § 2142.

Accordingly, it is critical, as discussed above, to determine who the “person of ordinary skill in the art” is before making a determination of obviousness.

D.2.1. Basic Requirements

To establish a *prima facie* case of obviousness for a claim, three basic criteria must be met:

1. There must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art;
2. There must be some reasonable expectation of success; and
3. The prior art reference (or references when combined) must teach or suggest all the claim limitations.

See M.P.E.P. § 2143.

The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. M.P.E.P. § 2143.01.

D.2.2. The Examiner Bears the Initial Burden of Factual Support

The examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness.

M.P.E.P. § 2142. The initial burden, therefore, is on the examiner to provide some suggestion of the desirability of doing what the inventor has done. M.P.E.P. § 2142.

D.3. The Examiner has Failed to Conduct the Required *Graham* Inquiries

We have carefully reviewed the Section 103 rejections of Claims 1-27 in the present Office Action to determine compliance with the Graham requirements. We respectfully submit that the Examiner has not followed Graham with respect to any rejection under Section 103.

Specifically, the Examiner has neither

- a) defined a level of ordinary skill in the art, nor
- b) clearly indicated any evidence in support of such a finding.

As discussed above, such findings are necessary in assessing obviousness.

M.P.E.P. § 2141.03; Iron Barbell 392 F.3d 1317; Ryko Mfg., 950 F.2d at 718.

As a result of the failure to resolve and consider the level of ordinary skill, the Examiner

(i) cannot have determined the scope and content of the prior art objectively, i.e., from the point of view of the hypothetical person having ordinary skill in the art at the time of invention, and thus

(ii) cannot have determined the differences between the cited references and the claims objectively, and also

(iii) cannot have determined objectively some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art.

As the Examiner has failed to conduct the required Graham factual inquiries, the Examiner cannot factually support any *prima facie* conclusion of obviousness with respect to any pending claim.

To the contrary, because the level of ordinary skill in the art was not defined and there is no evidence of record that the Examiner's findings are objective, the record indicates only that the rejected claims were obvious (i) to the Examiner

(who has the benefit of our own disclosure), (ii) at the time the present Office Action was written.

D.4. Request for Required Factual Support

In any subsequent Office Action asserting a Section 103 rejection, we respectfully request that the Examiner clearly indicate, with respect to each rejected claim, the support in the record for the findings required under the Graham factual inquiries: (i) the level of ordinary skill in the pertinent art; (ii) the scope and contents of the prior art; (iii) the differences between the prior art and the claims in issue; and (iv) any evidence of secondary considerations.

In particular, we respectfully request that the Examiner (i) define and (ii) submit evidence of the level of ordinary skill. Some factors that may be considered in determining the ordinary level of skill in the art are outlined at M.P.E.P. § 2141.03.

D.5. The Examiner has Failed to Meet the Basic Criteria for *Prima Facie* Obviousness

The Examiner has failed to make the requisite factual findings required under Graham (outlined above) and thus cannot factually support a *prima facie* conclusion of obviousness with respect to any claim.

For example, without resolving the level of ordinary skill in the art, the Examiner has no factual support for an assertion that either (a) a claimed feature or (b) a motivation to combine / modify references may be found objectively either (i) in the references themselves, (ii) in the knowledge generally available to one of ordinary skill in the art, or (iii) in the nature of the problem to be solved.

We submit that the level of ordinary skill at the time of invention was low.

In addition, the Examiner has failed to make any assertion of a reasonable expectation of success with respect to any claim.

For at least these reasons, we respectfully submit that the Examiner has failed to establish a *prima facie* case of obviousness for any pending claim.

Some criteria that have not been met with respect to particular claims are discussed further herein.

D.6. Independent Claims 75, 107, and 108

We respectfully submit that none of the independent claims (Claims **75, 107, and 108**) is obvious in light of Raven or Plainfield, either alone or in combination.

First, no combination of Raven and Plainfield teaches or suggests all of the features of the independent claims. Second, there is no suggestion or motivation, either in the cited references or in the knowledge generally available to one of ordinary skill in the art, to modify or to combine the cited references to provide for all of the claimed features of independent Claims 75, 107, and 108.

D.6.1. The References Do Not Disclose All the Limitations of the Independent Claims

No combination of the Raven and Plainfield references suggests any of the features of: *selecting the player to receive a survey question based on the (determined) gambling history (of the player), transmitting the survey question to the player via a slot machine, or providing determined compensation for a response to a survey question to the player via a slot machine.* The Examiner has not provided any evidence that it was known or desirable to select a player to receive a survey question via a slot machine based on any information about the player (much less gambling history).

As we best understand the rejection, the Examiner implies that Raven teaches all of the features of the independent claims except “compensating a selected the [sic] player for responding to a survey.” [Office Action, page 3].

We agree that Raven does not suggest compensating a selected player for responding to a survey. We disagree that Raven teaches all of the other features of any independent claim. Plainfield and Raven are devoid of any hint of transmitting survey or marketing questions to anyone via a slot machine.

The Examiner makes several assertions as to teachings of Raven, but does not correlate those assertions to any particular limitations of the independent claims. Thus, the Examiner has failed to articulate any reasoned findings that any particular feature of the independent claims is taught by Raven. The Examiner has failed to establish a *prima facie* case of obviousness for at least this reason.

The Examiner asserts: “Raven et al teaches programmed slot machines and networks which identify players and deliver promotional messages to the players [abstract].” [Office Action, page 3].

We respectfully disagree with any implication that Raven suggests that identifying a player has anything to do with delivering “promotional messages” (or any other type of message) to that identified player. There is nothing in Raven, for example, that would suggest the desirability of selecting a particular player to receive a “promotional message.”

The Examiner also appears to find it relevant that Raven teaches that certain players may be designated as “special” based on “card data” and “treated differently” based on the amount the player is currently playing. [Office Action, page 3]. The Examiner implies that “treated differently” suggests that “special players” would receive particular messages. However, nothing in Raven remotely suggests providing messages or survey questions to a “special player,” or that whether a player is “special” has anything to do with any information transmitted to the player via a slot machine. Raven includes the following description:

It is another object of the invention to provide a signal to casino personnel to identify special players. [Column 1, lines 65-67].

As previously mentioned, in the preferred embodiment a multi-color LED 36 is provided on the DMK 12. This LED 36 is lighted to indicate to casino personnel that a special player, e.g., a “high roller” or “VIP” is playing the game, and may be worthy of special treatment. The criteria for each color may be defined by the casino, and may be based on data stored on the player’s card as well as the amount being played. [Column 9, lines 61-67].

Thus, whether a player is “special” is described in Raven as a reason for signaling to “casino personnel” that the player may be “worthy of special treatment.” There is no discussion in Raven as to what “special treatment” by “casino personnel” may mean. There is no suggestion in Raven that “special treatment” by “casino personnel” has anything to do with whether any type of message is sent to that player via a slot machine. Accordingly, there is no hint in Raven that a “special player,” “card data,” or “the amount being played by the player” has anything to do with selecting a player to receive any type of message via a slot machine, much less a survey question.

The Examiner asserts: “Raven et al teaches that messages may request that the player respond interactively to enter requested information [5:63-64]....” [Office Action, page 3].

Nothing in Raven, however, indicates that the “player reply message” discussed at the cited portion suggests a survey question or that the “requested information” relates in any way to a survey question. The Examiner, who has neither examined nor defined the level of ordinary skill in the art, does not indicate any factual findings supporting a conclusion that one having ordinary skill in the art would have interpreted “player reply message” or “requested information,” as discussed in Raven, as suggesting a survey question.

In fact, as we understand Raven, the only “requested information” in Raven is either a “personal identification number (PIN)” or a “credit request.” The “PIN” and “credit request” are “transmitted to the system for verification.” [Column 8,

lines 14-16; Column 10, lines 49-62]. Nothing in Raven or otherwise of record indicates that a prompt for a “PIN” or a “credit request” suggests a survey question to one of only ordinary skill in the art.

Also, nothing in Raven suggests that the “promotional messages” noted by the Examiner comprise any questions to a player, much less survey questions to which a player may respond. In fact, the “promotional messages” are clearly distinguished in Raven from the “player reply messages,” which would indicate that no “player reply” to a “promotional message” is provided or desirable in the Raven system. [see Column 5, lines 57-63].

According to the Examiner: “Plainfield et al teaches surveying identified customers and rewarding the customers for responding as a means to create an incentive for participating in the marketing survey.” [Office Action, page 3].

We respectfully disagree. Plainfield does not teach “surveying identified customers”—to the contrary, it suggests presenting survey questions to unidentified people (any passersby). Contrary to the Examiner’s implication, Plainfield also does not suggest selecting any particular customer for a survey question, much less selecting a customer for a survey question based on information about the customer, much less gambling history.

In fact, Plainfield is directed to getting information from customers about whom nothing is known for the purpose of establishing a mailing list. There is no hint of the desirability of discriminating (for any purpose) among customers based on information about the customers. For example, Plainfield teaches that an as-yet anonymous passerby is prompted for information on the same display screen at the same time the customer may be prompted with survey questions. Accordingly, there is nothing in Plainfield that would suggest that any determination is being made to transmit a survey question to a customer based on any information about the customer—the system knows nothing about the passerby when the survey questions are presented.

Thus, no combination of the cited Raven and Plainfield references would suggest any of the features of *selecting the player to receive a survey question based on the (determined) gambling history (of the player) or transmitting the survey question to the player via a slot machine*. Accordingly, there is no suggestion of *providing determined compensation for a response to a survey question to the player*, much less *transmitting a signal to a slot machine* to do so.

Accordingly, the Examiner has failed to establish a *prima facie* case of obviousness for any of the independent claims (Claims **75, 107, and 108**).

D.6.2. No motivation to combine the Raven and Plainfield references

Further, there is no evidence of record that it would have been obvious to combine Raven and Plainfield.

The references are not analogous. The Examiner has not made any finding as to the level of ordinary skill in the art, and thus cannot have established any reasoned finding as to why one of ordinary skill would have considered the casino gaming system of Raven to be somehow analogous to the mailing list system of Plainfield.

There is also no reasoned finding that it would have been desirable to present a survey question to a particular player at a slot machine, much less that the player may be selected based on information about his gambling history, much less transmitting a signal to a slot machine to provide determined compensation to the player.

The mere fact that “special players” are mentioned in Raven and presenting survey questions is mentioned in Plainfield is not substantial evidence of such a motivation. Also, there is no finding of the level of ordinary skill, so there is no objective evidence that any combination of Raven and Plainfield would have been deemed desirable by one of only ordinary skill before the time of invention.

No evidence of a motivation to provide for any of the specific features is provided of record. There is no suggestion that it would have been obvious to select a player for a survey question via a slot machine based on anything, much less based on gambling history. Further, as discussed above, even if a motivation were of record, the Examiner’s proposed combination would not provide for all of the features of any of the independent claims.

The Examiner has failed to establish a *prima facie* case of obviousness for at least these reasons.

Accordingly, we respectfully request reconsideration of the § 103(a) rejections of all of pending claims **75-108**.

D.7. Claims 76, 102, and 103

With respect to Claims **76, 102, and 103**, the Examiner asserts: “it would have been obvious...to have selected any type of player, including losing players, for rewarding participation in a data gathering survey, so that the survey data could be collected for any type of targeted segment.” [Office Action, page 4].

The Examiner does not indicate any teaching in the record for any of these assertions.

There is no support in the record for these assertions. Also, as discussed above, there is no suggestion in the record of selecting particular people for receiving questions or compensation, how “any type of player” could be selected (much less “losing players”), or “targeted segments.”

Accordingly, the Examiner has failed to establish a *prima facie* case of obviousness for any of Claims **76, 102, and 103**.

D.8. Claims 79 and 80

The Examiner asserts: “the reward can be viewed by the player as ‘offsetting or ‘erasing’ a loss.” [Office Action, page 4].

The Examiner does not indicate any support for this assertion.

There is no support in the record for any assertion as to how a player might view compensation for responding to a survey question, and no evidence of record that one having only ordinary skill in the art would have known compensation for a survey question response could have anything to do specifically with a gambling loss.

Accordingly, the Examiner has failed to establish a *prima facie* case of obviousness for any of Claims **79 and 80**.

D.9. Claims 82-97

The Examiner takes Official Notice that “casinos ‘comp’ players with free plays/tokens, credits, cash, reduced rates, free rooms and to manipulate the prize tables, activate additional paylines/reels in order to increase the players chance of winning....” The Examiner also takes Official Notice that it would have been obvious to “have credited the players with free/bonus points or credits to be used at any machine including video poker (a game of skill).” [Office Action, pages 4-5].

The Examiner does not indicate any support for these assertions.

There is no support in the record for these general and unsupported assertions as to how casinos “comp” players, what “comp” has to do with compensation for a response to a survey question, or that the types of compensation recited in claims **82-97** would have been known.

There is no evidence of record that compensation provided via a slot machine for a response comprising any of the following would have been known to one having ordinary skill in the art:

- participation in a game of skill (Claim 82)
- a gambling token (Claim 83)
- an increase in odds of winning in a game of chance (Claim 84)
- an increased prize table (Claim 85)
- an insurance protection against a loss (Claim 86)
- an ability to play a higher denomination currency gaming machine for a lower denomination currency (Claim 87)
- a free use of an extra slot in a multi-slot slot machine (Claim 88)
- an ability to play the slot machine for free (Claim 89)
- an ability to have winnings rounded up to a higher level (Claim 90)
- a free room (Claim 91)
- a subsidized room (Claim 92)
- activating an inactive payline (Claim 93)
- allowing the player to receive a prize corresponding to an outcome on an inactive payline (Claim 94)
- retroactively activating a payline in exchange for gambling plays (Claim 95)
- cash (Claim 96)
- credit (Claim 97).

No substantial evidence of this subject matter has been established of record. Accordingly, the Examiner has failed to establish a *prima facie* case of obviousness for any of Claims 82-97.

D.10. Claims 99-101

The Examiner asserts: “it would have been obvious to one of ordinary skill at the time of the invention to have provided the survey question(s) at any time during the gambling session.” [Office Action, page 5].

The Examiner does not indicate any support of record for this assertion.

There is no support in the record for this assertion. Specifically, there is no suggestion of providing survey questions during a gambling session, much less that it is desirable to providing survey questions at any particular time.

Further, each of Claims **99-101** has been amended to recite determining a particular condition, and transmitting a survey question in response to the respective determination. Nothing in the cited references teaches or suggests in which transmitting a survey question comprises any of:

determining that the player is losing; and

transmitting the survey question in response to determining that the player is losing

as recited in Claim **99**;

determining that a reel of the slot machine is spinning; and

transmitting the survey question in response to determining that the reel of the slot machine is spinning

as recited in Claim **100**; or

determining that a coin is dropping at the slot machine; and

transmitting the survey question in response to determining that the coin is dropping at the slot machine

as recited in Claim **101**.

Accordingly, the Examiner has failed to establish a *prima facie* case of obviousness for any of Claims **99-101**.

D.11. Claims 76-78, 84, 102, and 103

The Examiner rejects Claims **76-78, 84, 102, and 103** over a combination of Raven, Plainfield and Liverance. We traverse these rejections.

The Examiner asserts: “it would have been obvious...to have targeted losing players of Raven et al and offered them opportunities to complete surveys in order to increase their chances of future winning if they participate and continue playing.” [Office Action, page 5].

We traverse this assertion. As discussed above, there is no suggestion in the cited references of targeting losing players to receive survey questions.

Nothing in any of the cited references hints at transmitting a survey question to a player selected by determining an amount lost gambling by the player and selecting the player based on the amount lost gambling, as recited in Claims **76 and 77**. Nothing in any of the cited references hints at transmitting a survey question to a player selected if the amount lost gambling is not less than a predetermined amount greater than zero, as now recited in Claim **78**.

As discussed above, nothing in the cited references hints at a feature in which the determined compensation for a response to a survey question comprises an increase in odds of winning in a game of chance, as recited in Claim **84**.

Contrary to the Examiner's unsupported assertion, nothing in the cited references teaches or suggests *generating an offer* based on anything, much less *based on the gambling history of the player*, as recited in Claims **102 and 103**. The Examiner asserts: "the reward-based survey itself can be taken to be an offer." This assertion is predicated on the convenient assumption that it was known to provide for a "reward-based survey" to a player based on the player's gambling history. As discussed herein, the Examiner has failed to establish evidence of record supporting this assumption.

Accordingly, the Examiner has failed to establish a *prima facie* case of obviousness of any of Claims **76-78, 84, 102, and 103**.

D.12. Claim 98

The Examiner rejects Claim **98** over Raven, Plainfield, and Paige. We traverse this rejection.

The Examiner asserts: "it would have been obvious...to have provided such ad-enhanced reels...in order to exploit the player's gambling attention for advertising revenue. In the obvious case of providing free points/credits/plays, the compensation is taken to be allowing the player to watch and play the ad-enhanced reels." [Office Action, page 6].

We do not understand these assertions.

As discussed above, the Examiner has not provided any evidence that it would have been obvious to provide for "free points/credits/plays" as compensation for a response to a survey question at a slot machine. It is not clear what the Examiner believes this would have to do with "allowing the player to

watch and play the ad-enhanced reels,” or how exploiting “the player’s gambling attention” would have been considered compensation for the player.

The Examiner has not provided any evidence that “providing ad-enhanced reels” would have been understood by one of only ordinary skill in the art as suggesting compensation for a player, much less compensation for the player responding to a survey question. Paige is devoid of any hint that logos are related to compensation to a player.

Accordingly, the Examiner has failed to establish a *prima facie* case of obviousness with respect to Claim 98.

D.13. Claim 104

The Examiner rejects Claim 104 over Raven, Plainfield, and Dyer. We traverse this rejection.

There is no evidence of record that it would have been obvious “to gather advertising and product information from casino customers.” [Office Action, page 6]. The Examiner’s statement amounts to no more than a conclusion of generalized advantage and a convenient assumption about what was allegedly known to those of ordinary skill in the art. Nothing in Dyer or in the cited references suggests the desirability of modifying Raven or Plainfield in the manner suggested by the Examiner.

Accordingly, the Examiner has failed to establish a *prima facie* case of obviousness with respect to Claim 104.

D.14. Claim 105

The Examiner rejects Claim 105 over Raven, Plainfield, and an unsupported assertion that “any response is taken to be a commitment for providing truthful answers.” We traverse this rejection.

We do not understand the Examiner’s assertion. Regardless, there is no evidence of record supporting the Examiner’s assertion or suggesting *a response comprising a commitment*, as generally recited Claim 105. Accordingly, the Examiner has failed to establish a *prima facie* case of obviousness with respect to Claim 105.

E. Official Notice

The Examiner’s rejection of some of the pending claims is based in part on unsupported general assertions of what would have been known or “obvious”

before the time of our invention. [Office Action, page 5.] We respectfully traverse the Examiner's Official Notice and other unsupported assertions as to what features or motivations would have been known to one of ordinary skill in the art.

The cited references do not support the Examiner's broad assertions as to what was well known; the Examiner does not assert otherwise.

No references have been provided for any of the Examiner's general assertions. Given that the only particular information in the record thus far regarding what is considered to be in the prior art is the Examiner's brief statement, we cannot properly determine the bounds of the prior art. Accordingly, we dispute that the subject matter asserted was "well known" at the time the invention was made, and request, for each of Claims **76, 79, 80, 82-97, 99-103, and 105**, a reference to clarify the subject matter in more detail. MPEP 2144.03.

Accordingly, the Examiner's sweeping assertions cannot be used as prior art to the present application – only the content of the references of record which are prior art to the present application may so used. "[D]eficiencies of the cited references cannot be remedied by the Board's general conclusions about what is 'basic knowledge' or 'common sense.'" In re Zurko, 258 F.3d 1379, 1385, 59 USPQ2d 1693, 1697 (Fed. Cir. 2001); In re Lee, 277 F.3d 1338, 1344, 61 USPQ2d 1430, 1434 (Fed. Cir. 2002).

Further, subject matter without an evidentiary basis cannot be used as the basis for a rejection under 102 or 103. Official Notice may be used, if at all, only to clarify the meaning of a reference. See, e.g., In re Ahlert, 424 F.2d 1088 (C.C.P.A. 1969) ("Typically, it is found necessary to take notice of facts which may be used to supplement or **clarify the teaching of a reference** disclosure, perhaps to justify or explain a particular inference to be drawn **from the reference** teaching.") (emphasis added).

F. Authorization to Charge Appropriate Fees & Petition for Extension of Time to Respond

We understand that a one-month extension of time to respond to the Office Action is necessary. Please grant a petition for any extension of time required to make this Response timely.

If necessary, please charge any appropriate fees necessary per the following information:

Charge: \$55.00
Deposit Account: 50-0271
Order No.: 99-110

Please credit any overpayment to the same account.

A duplicate copy of this authorization is enclosed for such purposes.


G. Conclusion

For at least the reasons stated herein, we respectfully request allowance of the pending. The Examiner's early re-examination and reconsideration are respectfully requested.

If the Examiner has any questions regarding this amendment or the present application, the Examiner is cordially requested to contact Michael Downs at telephone number (203) 461-7292 or via electronic mail at mdowns@walkerdigital.com.

Respectfully submitted,

March 21, 2005
Date



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